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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,680 06/29/99 ANDERSON

E 1418CIP/P160

EXAMINER

TM02/0702

STEPHEN G SULLIVAN
SAWYER & ASSOCIATES
POST OFFICE BOX 51418
PALO ALTO CA 94303

HUYNH, C

ART UNIT

PAPER NUMBER

2176

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

gm

Office Action Summary	Application No. 09/342,680	Applicant(s) ANDERSON ET AL.	
	Examiner Cong-Lac Huynh	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>Z</u> . | 20) <input type="checkbox"/> Other: |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 6/4/01 to the application filed on 06/29/99.
2. Claims 1-20 are pending in the case. Claims 1, 8, 13 are independent claims.
3. The objection of the specification as not including the status of the US co-pending application 09/059,611 has been withdrawn in view of updating.
4. The rejection of the PTO-form 1449 as not including the date of publication of the references has been withdrawn in view of a revised PTO-form 1449.
5. The rejections of claims 2 and 4 under 35 U.S.C. 112, second paragraph, as being indefinite have been withdrawn in view of the amendment.
6. The rejections of claims 1-20 under 35 U.S.C. 103(b) as being anticipated by Narayen et al. (6,035,323) have been withdrawn as pursuant to the applicant's argument.

Claim Rejections – 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 2176

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 8, 11-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (US Pat No. 5,848,420 12/8/98, filed 6/14/96) in view of Narayen et al. (US Pat No. 6,035,323, 3/7/00, filed 10/24/97).

Regarding independent claim 1, Xu discloses:

- connection between the digital camera and the computer (figure 1; col 3, lines 55-67 to col 4, lines 1-3; col 4, lines 30-45)
- mounting the image capture device as a disk on the host computer (abstract; col 2, lines 15-35; col 3, lines 55-65)

Xu does not disclose generating the image files stored in the digital camera into HTML format and opening these files in the computer system without loading any camera-specific software.

Narayan discloses:

- saving images from a digital camera to the hard disk of the computer (figure 4, steps 201, 203)

Art Unit: 2176

- generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229)
- establishing communication between the image capture device and the host computer (col 5, lines 50-67; col 6, lines 28-45)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Xu into Narayen to obtain the connection between a PC and a digital camera, and the creating a HTML file containing images from the digital camera.

Xu and Narayen do not explicitly disclose opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have known that once created, the HTML file can be viewed by the Netscape browser, which is a web browser, in the host computer without loading any communication software onto the host computer.

Such combination will give users the convenience of accessing and browsing image files in the digital camera mounted in the operation system of the host computer as well as browsing HTML files based on the images from the digital camera using a web browser of the host computer.

Art Unit: 2176

Claims 8,13 are for the system and the computer-readable medium of method claim 1, and therefore are rejected under the same rationale.

Regarding claims 11-12, it was obvious that the Internet page is a HTML page and images are transferred from a digital camera to the host computer and the Internet as disclosed above.

10. Claims 2-5, 9-10, 14-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayan as applied to claim 1 above, and further in view of Cohen et al. (US Pat No. 5,805,829, 9/8/98, filed 10/1/96).

Regarding claim 2, which is dependent on claim 1, Narayan and Xu do not disclose the providing of Java files with the Internet page description files in the image capture device.

Cohen discloses that a web page can include programs of Java files called applets for execution live images of the web page content (col 1, lines 20-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cohen into Narayan and Xu for providing Java files along with the internet page file for executing images captured from the image capture device connected to the host computer.

Art Unit: 2176

Regarding claim 3, which is dependent on claim 2, it was well known that compressing is applied for easy transferring image files, which can be Java files as in Cohen, with a large amount of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said files should be executed for decompressing and for displaying on the web browser.

Regarding claim 4, which is dependent on claim 3, Narayen discloses the generating the Internet page description when the communication with the host computer is indicated (figures 1, 4, 8).

Regarding claim 5, which is dependent on claim 4, Narayen discloses the storing of the images displayed in the web browser on the host computer by copying the compressed images files from the image capture device directly to the host computer (col 6, lines 31-45).

Claims 9-10, 14-18 are for the system and the computer-readable medium of method claims 2-5 and therefore are rejected under the same rationale.

11. Claims 6-7, 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 5 above, and further in view of Wang et al. (US Pat No. 6,058,428, 2/5/00, filed 12/5/97).

Art Unit: 2176

Regarding claim 6, which is dependent on claim 5, Xu and Narayen do not disclose the copying of image files, which is determined not being previously copied, to the host computer.

Wang discloses:

- determining if any of the compressed image files have previously been copied to the host computer (col 5, lines 59-67; col 6, lines 42-50)
- copying only the compressed image files to the host computer that have not been previously copied (col 5, lines 59-67; col 6, lines 42-50)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Wang into Narayen to enhance that feature to Xu and Narayen to avoid the duplicate files when copying.

Regarding claim 7, which is dependent on claim 6, Narayen discloses:

- uploading the image files and the internet page description file to the host computer (figures 4, 5, 9)
- opening the internet page description file in the web browser on the host computer to display the images stored in the host computer (figures 4, 5, 9)

Though Narayen does not explicitly disclose the computer on which the web page displayed is the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said computer is a host computer as claimed since it is connected to the digital camera and is where to display images from the digital camera.

Claims 19-20 are for the computer-readable medium of method claims 6-7, and therefore are rejected under the same rationale.

Response to Arguments

12. Applicant's arguments filed 6/4/01 have been fully considered but they are not persuasive.

Applicants argue that neither Xu nor Narayen, singularly or in combination, teach or suggest "mounting the image capture device – such as a digital camera-- as a disk onto the host computer without the need for loading a communication software onto the host computer (remark, page 5). Xu would not be able to mount the digital camera as a disk onto the computer without the software program (remark, page 4).

Examiner disagrees.

First, the limitation "*mounting the image capture device as a disk* onto the host computer *without the need for loading a communication software* onto the host computer" is not claimed and is not the invention. Only "*mounting the image capture device as a disk* onto the host computer" is claimed.

Second, the limitation "*without the need for loading a communication software* onto the host computer" is claimed in combination with "opening the Internet page description file in a web browser on the host computer, wherein the image stored in the image capture device are displayed on the host computer through the web browser" (claim 1).

Art Unit: 2176

This is verified in the specification (page 1, lines 11-14, viewing images from an image capture device on a host computer, and more particularly to a method and system for *viewing images from an image capture device on the host computer without having to load device-specific software onto the host*).

Xu discloses mounting the image capture device as a disk onto the host computer (col 2, lines 15-32; col 3, lines 55-67; col 4, lines 32-39).

Narayan discloses generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229)

Xu and Narayan do not explicitly disclose opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that a HTML file, once generated, can be viewed by the Netscape browser, which is a web browser, in the host computer without loading any communication software onto the host computer.

Therefore, Xu and Narayan do teach the required features.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is (703)-305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this Art Unit is (703) 308-5403.

15. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Art Unit: 2176

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

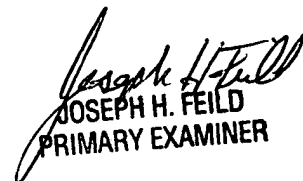
(703) 308-5403 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington. VA. Sixth Floor (Receptionist).

clh

6/26/01


JOSEPH H. FEILD
PRIMARY EXAMINER